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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,871	03/04/2004	Kazuhiko Yoshida	046601-5129	5247
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MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			EXAMINER MORRISON, THOMAS A	
			ART UNIT 3653	PAPER NUMBER
DATE MAILED: 02/13/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/791,871	<b>Applicant(s)</b> YOSHIDA ET AL.	
	<b>Examiner</b> Thomas A. Morrison	<b>Art Unit</b> 3653	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Specification*

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The specification fails to provide proper antecedent basis for (a) the claimed enclosure set forth in claims 1, 3, 7, 8, 14 and their dependent claims; (b) the claimed face portion set forth in claims 1, 2, 3, 7, 8, 14 and their dependent claims; (c) the claimed another sheet transporting device set forth in claims 1 and 3 and their dependent claims; (d) the claimed first guide part set forth in claims 1, 2, 3, 7, 8, 14 and their dependent claims; (e) the claimed second guide part set forth in claims 1, 2, 3, 7, 8, 14 and their dependent claims; (f) the claimed sheet transporting device set forth in at least claims 7, 8, 14 and their dependent claims; (g) the claimed sheet ejection unit set forth in claims 10-11; (h) the claimed sheet ejection reversal unit set forth in claims 10-11; (i) the claimed reversal transport passage set forth in claims 17-19; and (j) the claimed branch set forth in claim 19. While it appears that structures that look like “an enclosure”, “a first guide part”, etc., are most likely shown in the drawings, the terminology used in the claims is inconsistent with the terminology that is used in the specification to describe what is shown in the drawings. As such, it is difficult to determine what terms in the specification and drawings match up with the terms in the claims.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 3-6, 11 and 14-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 3 and their dependent claims, it is confusing as to how a sheet transporting device can comprise another sheet transporting device. More specifically, claims 1 and 3 are confusing because these claims both recite "A sheet transporting device comprising: ...another sheet transporting device".

Regarding claim 11, there is insufficient structure recited in this claim to understand how the sheet reversal ejection unit holds the sheet at a pressure higher than the sheet ejection unit.

Regarding claim 14, it is unclear if the recited cover part is removed or in place on the enclosure. More specifically, claim 15 recites a cover part that covers an exposed portion of the enclosure, and also recites the portion where the cover part is removed.

Regarding claim 19, there is insufficient structure recited in this claim to understand how the sheet is reversed.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-12 and 14-19, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Publication No. 10-129912. In particular, Japanese Publication No. 10-129912 discloses all of the limitations of claims 1-12 and 14-19.

Regarding claim 1, Figs. 1-3 and 12-15 show a sheet transporting device including

an enclosure (12) that includes a first guide part (e.g., guide part between 28 and 44 in Fig. 1) at least a part of which can be exposed to outside (near 44),

another sheet transporting device (10) that includes a second guide part (e.g., guide part between 58 and 94 in Fig. 1) at least a part of which is exposed to outside (near 94), and

a face portion (including 46 and 92 in Fig. 12) located at the first guide part and the second guide part,

at least a part of a sheet transporting passage (e.g., a sheet transporting passage extending all the way from 94 past 58 and 52 and then extending past 20, 22,

28 and up to 44) that includes the first guide part and the second guide part, wherein the another sheet transporting device (10) is attached to the enclosure (12)(see Fig. 1).

Regarding claim 2, Figs. 1-3 and 12-15 show a sheet transporting device including

a first guide part (e.g., guide part between 28 and 44 in Fig. 1) at least a part of which can be exposed to outside (near 44 in Fig. 2), and

a second guide part (e.g., guide part between 58 and 94 in Fig. 1) at least a part of which is exposed to outside (near 94) and which is provided in an enclosure (50) to be attached to an image forming apparatus, wherein at least a part of a sheet transporting passage (e.g., a sheet transporting passage extending all the way from 94 past 58 and 52 and then extending past 20, 22, 28 and up to 44) includes the first guide part and the second guide part, and a face portion (including 46 and 92 in Fig. 12) located at the first guide part and the second guide part.

Regarding claim 3, Figs. 1-3 and 12-15 show a sheet transporting device including

an enclosure (12) that includes a first guide part (e.g., guide part between 28 and 44 in Fig. 1) at least a part of which can be exposed to outside (near 44 in Fig. 2); and

another sheet transporting device (10) to be attached to the enclosure (12), wherein the another sheet transporting device (10) includes a second guide part (e.g., guide part between 58 and 94 in Fig. 1) at least a part of which is exposed to outside

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(near 94), and at least a part of a sheet transporting passage (e.g., a sheet transporting passage extending all the way from 94 past 58 and 52 and then extending past 20, 22, 28 and up to 44) includes the first guide part and the second guide part, and a face portion (including 46 and 92 in Fig. 12) located at the first guide part and the second guide part.

Regarding claim 4, the English Abstract discloses that the another sheet transporting device (10) is a two-sided unit which reverses a sheet.

Regarding claim 5, Figs. 1-3 and 12-15 show that the another sheet transporting device (10) is a sheet supply unit which supplies a sheet.

Regarding claim 6, Fig. 12 shows that the another sheet transporting device (10) includes a sheet guide unit (96 in Fig. 12) which guides a sheet from the enclosure (12).

Regarding claim 7, Figs. 1-3 and 12-15 show an image forming apparatus including

an enclosure (12) that includes a first guide part (e.g., guide part between 28 and 44 in Fig. 1) at least a part of which can be exposed to outside (near 44 in Fig. 2),

a sheet transporting device (10) that includes a second guide part (e.g., guide part between 58 and 94 in Fig. 1) at least a part of which is exposed to outside (near 94), and

a face portion (including 46 and 92 in Fig. 12) located at the first guide part and the second guide part,

at least a part of a sheet transporting passage (e.g., a sheet transporting passage extending all the way from 94 past 58 and 52 and then extending past 20, 22, 28 and up to 44) includes the first guide part and the second guide part, wherein the sheet transporting device (10) is attached to the enclosure (12).

Regarding claim 8, Figs. 1-3 and 12-15 show an image forming apparatus including

an enclosure (12) that includes a first guide part (e.g., guide part between 28 and 44 in Fig. 1) at least a part of which can be exposed to outside (near 44);

a sheet transporting device (10) to be attached to the enclosure (12), wherein the sheet transporting device (10) includes a second guide part (e.g., guide part between 58 and 94 in Fig. 1) at least a part of which is exposed to outside (near 94), and at least a part of a sheet transporting passage (e.g., a sheet transporting passage extending all the way from 94 past 58 and 52 and then extending past 20, 22, 28 and up to 44) includes the first guide part and the second guide part, and

a face portion (including 46 and 92) located at the first guide part and the second guide part.

Regarding claim 9, the numbered paragraph [0018] of the English translation of detailed description of Japanese Publication No. 10-129912 discloses that the enclosure (12) houses at least a fixing device (26 and 28) which fixes a toner image to a sheet.



Regarding claim 10, Figs. 1-3 and 12-15 show that the enclosure (12) further includes a sheet ejection unit (38), the sheet transporting device (10) further includes a sheet reversal ejection unit (including 94) which reverses and ejects the sheet, and the sheet reversal ejection unit (including 94) is more distant from the fixing device (26 and 28) than the sheet ejection unit (including 38).

Regarding claim 11, it is noted that the structure of the sheet reversal ejection unit and the sheet ejection unit of Japanese Publication No. 10-129912 appears to be substantially similar to the structure of the sheet reversal ejection unit and the sheet ejection unit, respectively, of the instant application. Thus, in as much as the sheet reversal ejection unit of the instant application holds a sheet at a pressure higher than the sheet ejection unit, so does the corresponding sheet reversal ejection unit of Japanese Publication No. 10-129912.

Regarding claim 12, Fig. 12 shows that the sheet transporting device (10) includes a sheet guide unit (96 in Fig. 12) which guides the sheet from the enclosure (12).

Regarding claim 14, Figs. 1-3 and 12-15 show an image forming apparatus including

an enclosure (12) that includes a first guide part (e.g., guide part between 28 and 44 in Fig. 1) at least a part of which can be exposed to outside (at 44 in Fig. 2) and which guides a sheet (e.g., guides a sheet via element 32),

a cover part (i.e., cover part of enclosure 12 located on the left side of the apparatus in Fig. 2 and extends between numeral 56 up to numeral 32 and then slants over and extends over to numeral 38) that covers an exposed portion (near 44) of the enclosure (12), and

a sheet transporting device (10) that includes a second guide part (e.g., guide part between 58 and 94 in Fig. 1) at least a part of which is exposed to outside (near 94) and which guides the sheet, in which at least a part of a sheet transport passage (e.g., a sheet transporting passage extending all the way from 94 past 58 and 52 and then extending past 20, 22, 28 and up to 44) includes the first guide part and the second guide part, and the sheet transporting device (10) is attached to the portion where the cover part is removed. In particular, the sheet transporting device (10) is attached to a portion where an opening (near 44 in Fig. 15) in the cover is located. In other words, the sheet transporting device (10) is attached to a portion where the cover is removed. Also, there is a face portion (including 46 and 92 in Fig. 12) located at the first guide part and the second guide part.

Regarding claim 15, Fig. 15 shows that a portion where the part is exposed to the outside (near 44) of the enclosure (12) is a vicinity of a fixing device (26 and 28).

Regarding claim 16, Fig. 2 shows that the first guide part (e.g., guide part between 28 and 44 in Fig. 1) is an outside guide part of the fixing unit (26 and 28).

Regarding claim 17, Figs. 1-2 and the English Abstract disclose that the second guide part (e.g., guide part between 58 and 94 in Fig. 1) is an inside guide provided in a

two-sided unit, the outside guide part (e.g., guide part between 28 and 44 in Fig. 1) of the fixing unit (26 and 28) and the inside guide (e.g., guide part between 58 and 94 in Fig. 1) pinch the sheet and create a part of a reversal transport passage of the sheet.

Regarding claim 18, Figs. 1-2 show a sheet supply cassette (14) which stores sheets (M) is provided at a lower part of the enclosure (12), and a transport passage which supplies the sheets from the sheet supply cassette (14) to the fixing device (26 and 28) is provided.

Regarding claim 19, Fig. 1 shows that the fixing device (26 and 28) is provided at an upper part of the enclosure (12), and a branch (near 96) which reverses the sheet is provided at a part of the transport passage, and communicates with the part of the reversal transport passage.

### ***Response to Arguments***

4. Applicant's arguments filed 11/09/2005 have been fully considered but they are not persuasive.

With regard to the indefiniteness rejection of the claim 14, it is confusing as to whether the cover part is removed or not removed. Further clarification is needed.

With regard to the indefiniteness rejection of the claim 19, it is unclear what structure allows the branch to reverse the sheet and communicate with the reversal transport passage, as claimed.

With regard to the rejection of claims 1-12 and 14-19 in view of Japanese Publication No. 10-129912, applicant argues that this Japanese publication does not

disclose or teach a face portion located at the first guide part and the second guide part, as claimed. In response, it is the examiner's position that this Japanese publication discloses a face portion (including 46 and 92) as claimed, as explained above in greater detail in the rejection of claims 1-12 and 14-19 under 35 U.S.C. 102(b).

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Morrison whose telephone number is (571) 272-7221. The examiner can normally be reached on M-F, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathy Matecki can be reached on (571) 272-6951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink that reads "Kathy Matecki". The signature is written in a cursive, flowing style.

**KATHY MATECKI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600**